

REMARKS

The Office Action dated January 13, 2005, has been received and carefully noted. The above amendments and the following remarks are submitted as a full and complete response thereto.

By this Amendment, the title, drawings and claims 1 and 6 have been amended. Support for the amendments to claims 1 and 6 can be found on at least page 8, lines 21-26, of the specification as originally filed. No new matter has been added. The amendments to the claims do not narrow the scope of the claims. Claims 1-10 are pending and respectfully submitted for consideration.

The drawings were objected to for minor informalities. Responsive to this objection, the drawings were amended as follows: in Fig. 2, step S28 was amended to read REPRODUCE ASSOCIATED CUSTOM FILE; and step S22 was amended to read NUMERICAL. In addition, in Fig. 2, the flow line between DVD? and VCD? Was changed from YES to "NO" to accurately reflect the control selection determination.

The title of the invention was objected to as not being descriptive of the invention. The Applicants have amended the title, responsive to the objection.

Claims 1-3, 5-8 and 10 were rejected under 35 U.S.C. § 102(e) as being anticipated by Uehara (U.S. Patent No. 6,118,738). The Applicants traverse the rejection and respectfully submit that claims 1-3, 5-8 and 10 recite subject matter that is neither disclosed nor suggested by Uehara.

Uehara discloses a disk storage device capable of storing a plurality of types of disks, or a plurality of disks of the same type, and managing these disks to improve the operability of the apparatus. The data reproducing apparatus of Uehara reproduces the

contents of the disks at a high continuity even as disks of different types are exchanged. In order to manage the disks stored in the disk storage device, there is provided a disk manager information memory device having a memory unit in which the disk storage location data, disk type data and control data necessary for reproducing each disk are pre-stored together with additional data for managing each disk.

The Office Action begins with a rejection of claim 6. Claim 6 recites control means for generating a custom file having said first recording medium alone registered therein; and playback means for playing back said first recording medium installed in said recording medium playback system in accordance with registered contents of said custom file. The Office Action took the position that Uehara discloses "playback means (see DVD reproduction system (205) and CD reproduction system (206) of Fig. 1) for playing back said first and second recording media installed in said recording medium playback system in accordance with registered contents of said custom file (see Fig. 1 CD reproduction system (206) DVD reproduction system (205) and col. 3, lines 59-67 and col. 6, lines 1-14)." See page 4 lines 1-5 of the Office Action. In contrast, Uehara does not disclose that the DVD and CD are played back in accordance with registered contents of the custom file, which was generated to have the first recording medium alone registered therein. Rather, Uehara discloses that each of the DVD and the CD has its own reproduction system and that the management of the DVD and the CD are read from the manager information memory device 300. However, the manager information memory device 300 of Uehara is not comparable to the custom file recited in claim 1 because it includes both DVD and CD management information.

As such, Uehara does not disclose or suggest the claimed custom file having first recording medium alone registered therein and having playback means for playing back the first recording medium in accordance with the registered contents of that custom file, as recited in claim 6.

With respect to claim 1, the Applicants respectfully submit that Uehara fails to disclose or suggest the claimed features of the invention. Claim 1 recites generating a custom file having the first recording medium alone registered therein. Similar to the discussion of claim 6 above, Uehara does not disclose or suggest the claimed custom file having first recording medium alone registered therein, as recited in claim 1.

According to U.S. patent practice, a reference must teach every element of a claim in order to properly anticipate the claim under 35 U.S.C. §102. In addition, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628,631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “Every element of the claimed invention must be arranged as in the claim. . . . [t]he identical invention must be shown in as complete detail as is contained in the patent claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989) (emphasis added). The Applicants respectfully submit that Uehara does not disclose or suggest generating a custom file having the first recording medium alone registered therein as arranged in claims 1 and 6. Accordingly, Uehara does not anticipate claims 1 and 6 nor are claims 1 and 6 obvious in view of Uehara. As such, the Applicant submits that claim 1 is allowable over the cited art.

Claims 4 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Uehara in view of Yamauchi et al. (U.S. Patent No. 6,020,982, "Yamauchi"). Claim 4 depends from claim 1 and claim 9 depends from claim 6. The Applicants traverse the rejection and respectfully submit that claims 4 and 9 recite subject matter that is neither disclosed nor suggested by the combination of Uehara and Yamauchi.

Yamauchi discloses an image data processing apparatus for digitally reproducing optical image data. A first sub-menu is displayed with respect to the mode operated and specified from the main menu, and a second sub-menu is displayed according to the mode operated and specified from the first sub-menu. The image data is processed in this system, which further includes recording means for recording the data having programmed the operation specification of the series of processing procedures with respect to a specific processing procedure, and execution means for automatically executing the specific processing operation on the basis of the data recorded in this recording means.

The Applicants respectfully submit that Yamauchi does not cure the deficiencies in Uehara with respect to claims 1 and 6, as Yamauchi also does not disclose or suggest a custom file having the first recording medium alone registered therein. As such, Uehara and Yamauchi, either singly or in combination, fail to disclose or suggest the features of the invention as recited in claims 1 and 6 and, therefore, dependent claims 4 and 9.

Under U.S. patent practice, the PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where

a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002). The Office Action restates the advantages of the present invention to justify the combination of references. There is, however, nothing in the applied references to evidence the desirability of these advantages in the disclosed structure.

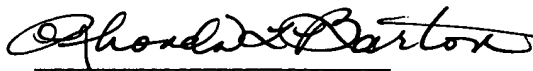
In view of the above, the Applicants respectfully submit that the Office Action has failed to establish a *prima facie* case of obviousness for purposes of a rejection of claims 4 and 9 under 35 U.S.C. §103.

Claims 2-5 depend from claim 1 and claims 7-10 depend from claim 6. The Applicants respectfully submit that these dependent claims are allowable at least because of their dependency from allowable base claims 1 and 6. Accordingly, the Applicants respectfully request withdrawal of the objections and rejections, allowance of claims 1-10, and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Dkt. No. 107156-00040.**

Respectfully submitted,



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Enclosures: Replacement Drawing Sheet - Figure 2
Petition for Extension of Time (Two-months)

AMENDMENTS TO THE DRAWINGS:

The Applicants respectfully presents herewith replacement Fig. 2, which includes the desired changes, without markings, and which complies with 37 C.F.R. §1.84. The changes made to Fig. 2 are explained in the accompanying remarks section below.